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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,521	06/29/2001	Jennifer O. Yiu	3399P049	8176

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EXAMINER	
LY, NGHI H	
ART UNIT	**PAPER NUMBER**
2686	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/895,521	YIU ET AL.	
	Examiner	Art Unit	
	Nghi H. Ly	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 August 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *26-36,45-53 and 56-59* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *26-36,45-53 and 56-59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 26, 28, 29, 35, 36, 45-47, 53, 53, 56, 58 and 59 are rejected under 35 U.S.C. 102(e) as being anticipated by Havinis et al (US 6,311,069).

Regarding claims 26, 45 and 56, Havinis teaches a method of dynamically controlling release of information on a network (see Abstract), the method comprising: intercepting, at an intermediary processing system (see column 3, lines 56 to column 4, line 2), a request sent from a mobile communication device to a network entity (see column 5, lines 41-65, or fig.4, see Accept 277, Reject 278 or Reject 295), the intermediary processing system coupled to the mobile communication device over a wireless network and to the network entity over a wired network (see fig.4), based on the intercepted request, determining in the intermediary processing system that protected information associated with the mobile communication device is needed by the network entity to fulfill the request, if said information is needed to fulfill the request (see column 5, lines 41-65 and see column 5, lines 65 to column 6, line 22), communicating with the mobile communication device to cause the mobile communication device to present a graphic user interface which allows allow a user of

the mobile communication device to dynamically control release of the protected information (see Abstract, column 3, lines 56 to column 4, line 2, and see column 5, lines 24-41), and releasing the protected information according to a result of said communicating (see Abstract, column 3, lines 56 to column 4, line 2, and see column 5, lines 24-41).

Regarding claims 28, 29, 46 and 47, Havinis further teaches the protected information comprises presence information relating to the mobile communication device (column 7, lines 50-60 see "position request").

Regarding claims 36, 53 and 59, Havinis further teaches the determining in the intermediary processing system that protected information associated with the mobile communication device (see column 1, lines 8-12) is needed by the network entity to fulfill the request is accomplished by looking up a table (see column 2, lines 28-41 and see column 7, lines 50-67).

Regarding claims 35, 52 and 58, Havinis further teaches communicating with the mobile communication device comprises transmitting second information to the mobile communication device over the wireless network (see column 3, lines 56-67), the second information for use by the mobile communication device to present a graphic user interface to enable the user to select from a plurality of options relating to release of the information (see Abstract, column 3, lines 56 to column 4, line 2, and see column 5, lines 24-41).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Havinis et al (US 6,311,069) in view of Dent (US 6,571,212).

Regarding claim 27, Havinis teaches a method as recited in claim 26. Havinis does not specifically disclose the communicating comprises using Hypertext Transport Protocol (HTTP) to communicate with the mobile communication device.

Dent teaches the communicating comprises using Hypertext Transport Protocol (HTTP) to communicate with the mobile communication device (see column 17, lines 13-17 and column 10, lines 7-9).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Dent into the system Havinis in order to provide secure protocols for IP voice network (see Dent, column 10, lines 7-9).

6. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Havinis et al (US 6,311,069) in view of Schroderus et al (US 5,907,804).

Regarding claim 30, Havinis teaches a method as recited in claim 26. Havinis does not specifically disclose the protected information comprises information identifying the mobile communication device or its user.

Schroderus teaches the protected information comprises information identifying the mobile communication device or its user (see column 5, lines 13-27).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Schroderus into the system Havinis in order to protect the identity of mobile equipment from unauthorized users.

7. Claims 31-34, 48-51 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havinis et al (US 6,311,069) in view of Raith (US 6,687,504).

Regarding claims 34 and 51, Havinis teaches claims 26 and 45. Havinis does not specifically disclose the network entity is a remote web-based application implemented on the wired network.

Raith teaches the network entity is a remote web-based application implemented on the wired network (see Raith, column 5, lines 10-21, column 5, line 66 to column 6, line 2 and see fig.2).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Raith into the system Havinis so that location information can be accessed through the Internet.

Regarding claims 31, 33, 48 and 50, Havinis teaches claims 26 and 45. Havinis does not specifically disclose operating as a proxy between the mobile communication device and the network entity.

Raith teaches operating as a proxy between the mobile communication device and the network entity (see Raith, fig.2, gateway 206).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Raith into the system Havinis so that location information can be accessed through the Internet.

Regarding claims 32, 49 and 57, Havinis teaches claims 26, 45 and 56. Havinis does not specifically disclose providing a gateway to interface the wireless network on which the mobile communication device operates with the wired network.

Raith teaches providing a gateway to interface the wireless network on which the mobile communication device operates with the wired network (see Raith, fig.2, gateway 206).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Raith into the system Havinis so that location information can be accessed through the Internet.

Response to Arguments

8. Applicant's arguments filed 08/30/2004 have been fully considered but they are not persuasive.

On pages 10-12 of applicant's remarks, applicant argues that "there is no indication or suggestion in Havinis that the MSC 14 or other subsystems disclosed therein intercepts a request sent from a MS 20 to another network entity or suggest that the MSC 14 or any other intermediary processing system causes the MS 20 to present a graphic user interface for a user to dynamically control the release of private information, Havinis only discloses that the MS 20 uses alerting tones and function keys on a MS 20, which does not constitute a graphic user interface".

The examiner, however, disagree. Havinis, column 3, lines 62-67, teaches "A request message, which contains a similar indicator to that of SETUP message in the mobile terminal calls, is sent by the serving Mobile Switching Center (MSC) to the mobile subscriber. The mobile subscriber can either accept or reject the positioning request based upon the LA identity displayed on the MS". In this case, the "request message" in Havinis is used to intercept the mobile subscriber and provide a LA identity displayed on the MS so that the mobile subscriber can either accept or reject the

positioning request based upon the LA identity displayed on the MS. Therefore, the teaching of Havinis indeed teaches applicant's claimed limitation.

On page 12 of applicant's remarks, applicant argues that "Havinis does not teach such a processing system and Raith does not teach such an intermediary processing system, either, the combination of Havinis and Raith fails to disclose or suggest each and every limitation in claim 45".

The examiner, however, disagree. Havinis does indeed teach a processing system (see the teaching of Havinis in claims 26, 45 and 56 above) and Raith does indeed teach an intermediary processing system (see Raith, fig.2, gateway 206), and the combination of Havinis and Raith does indeed teach applicant's claimed limitation with the broadest reasonable interpretation because the applicant's claimed limitation fails to further recite what an intermediary processing system is.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

01/12/05

Marsha D Banks-Harold

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